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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,775	06/29/2001	Will H. Gardenswartz	209745US25XCONT	5962

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EXAMINER
CHAMPAGNE, DONALD

ART UNIT	PAPER NUMBER
3622	6

DATE MAILED: 02/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)
	09/893,775	GARDENSWARTZ ET AL.
	Examin r	Art Unit
	Donald L. Champagne	3622

-- The MAILING DATE of this communication appears on the cover sh et with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 June 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-42* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-42* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☒ The proposed drawing correction filed on *29 June 2001* is: a)☒ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Pri rity under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Doubl Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

   A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 10-14, 24-28 and 38-42 are rejected under 35 U.S.C. 101 as claiming the same invention, respectively, as that of claims 6-10, 16-20 and 26-30 of Gardenswartz et al., US pat. 6,298,330. The two sets of claims are identical, except that instant claim 28 depends on instant claim 24. To be identical to claim 20 in Gardenswartz et al., instant claim 28 would have to depend on instant claim 27.

Claim Rejections - 35 USC § 102 and 35 USC § 103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

   > A person shall be entitled to a patent unless –
   >
   > (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-4, 15-18 and 29-32 are rejected under 35 USC 102(e) as anticipated by Biorge et al.

6. Biorge et al. teaches (independent claims 1 15 and 39) a method, a computer readable medium containing a computer program for executing the method, and a system for delivering *incentive credits,* which reads on targeted advertising, comprising: receiving from a first computer *(the portable device)* a first identifier *(encrypted signals)* identifying the first computer, and associated with an observed offline purchase history of a consumer, including purchase information collected when the purchase transpired, and electronically delivering the credits/ targeted advertising to the consumer at the first computer in response to receiving the first identifier (col. 5 lines 2-3 and 23-29). The credits in the first computer are derived from and therefore associated with an observed offline purchase history of a consumer.

7. Biorge et al. also teaches (independent claims 3, 17 and 31, and dependent claims 2, 4, 16, 18, 30 and 32) *generating* the first identifier *(encrypted signals,* col. 10 lines 22-26), where *encrypted signals* reads on a cookie.

8. Claims 5-9, 19-23 and 33-37 are rejected under 35 USC 102(e) as anticipated by, or, in the alternative, as obvious over, Biorge et al.

9. Biorge et al teaches (5, 19 and 33) receiving a second identifier (user *code, col.* 5 lines 5-10) corresponding to the consumer from the first computer. Biorge et al. also teaches that the consumer carries the first computer *(the portable device)* and enters the user code therein to validate the user (col. 5 lines 3-8), which reads on associating the first identifier with the consumer by linking the first identifier to the second identifier.

10. Biorge et al does not teach sending the first identifier to the first computer. However, since Biorge et al. teach the method claimed, under the principles of inherency (MPEP § 2112.02) the invention is considered to be anticipated in this regard by Biorge et al. As evidence tending to show inherency, it is noted that the first identifier

must be placed within the first computer, even at the time of its manufacture, and that reads on sending the identifier to the computer.

11. Biorge et al also teaches (claims 6, 20 and 34) classifying the consumer by purchase behavior/history and selecting the credit/ targeted advertising based thereon (col. 5 lines 23-27). Biorge et al also teaches (claims 7, 21 and 35) that the targeted advertisement is a credit, which is an inherent incentive to change or continue an established purchase behavior.

12. Biorge et al. does not teach (claims 8, 22 and 36) that the behavioral pattern also includes purchasing the product (see para. 13 below) within a time period. Official Notice is taken (MPEP § 2144.03) that this limitation was common at the time of the invention. Incentives almost invariably have an expiration date. Because it would be difficult to account for incentives without expiration dates, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add a limited time period or expiry date to teaching of Biorge et el.

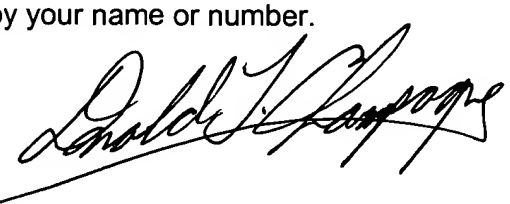
13. Biorge et al. teaches (claims 9, 23 and 37) presenting an award to the consumer in a retail store if the consumer complies with the behavioral pattern (col. 5 lines 32-33), where the behavioral pattern is defined by an amount of at least one specified product (col. 5 lines 57-59).

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 703-308-3331. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications may be sent directly to the examiner at 703-746-5536.

15. The examiner's supervisor, Eric Stamber, can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular official communications and 703-872-9327 for After Final official communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.

16. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.



Donald L. Champagne
Examiner
Art Unit 3622

22 February 2003